

Remarks:

Claims 1 and 3-14 were pending prior to entry of the present amendments, claims 15-18 having been withdrawn with traverse pursuant to a restriction requirement. Claims 1 and 13 have been amended. No new matter has been added.

Claims 1 and 3-14 remain pending for examination on the merits. Reconsideration is respectfully requested in view of the above amendments and following remarks.

Inventorship

Applicants acknowledge that the inventorship has been corrected and note that a corrected filing receipt has not yet been received to reflect the correct inventorship. Applicants respectfully request that the Examiner confirm that the Office records have been corrected and that the OIPE will issue a corrected filing receipt in due course.

35 U.S.C. § 101 Rejection

Claims 1 and 3-14 stand rejected under 35 U.S.C. § 101 as being drawn to nonstatutory subject matter. Claims 1 and 13 are independent, claims 3-12 depending from claim 1, and claim 14 depending from claim 13.

Claim 1 has been amended to recite “a method of using a resonator device” including steps of “accommodating the sample in the resonator device” and “measuring quantitatively at least one macroscopic physical property of the sample by interaction of said sample with sound waves generated by the resonator device.” Support for the amendment can be found in the specification at least at paragraphs 0013, 0023, 0033, and 0038, and in FIG. 2. In particular, the specification discloses as exemplary embodiments of such a resonator device the RESOSCAN® system and the ultrasonic PVT system, both sold by RESONIC Instruments AG, it being understood that implementation of the claimed invention is not limited to the listed exemplary systems.

Claim 13 has similarly been amended to recite “a method of using a resonator device” including a step of “measuring at least one sound velocity value through said sample at, at least one temperature or pressure, of sound waves generated by the resonator device.”

Support for the amendment can be found in the specification at least at paragraphs 0013, 0023, 0033, and 0038, and in FIG. 2.

As pointed out by the Examiner, *In re Bilski*, 545 F.3d 945, 954 (Fed. Cir. 2008) (en banc), held that the “machine-or-transformation” test is the test for analyzing whether method and process claims are directed to patentable subject matter. *See Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). In other words, the method or process must either transform an article into a different state or thing or be tied to a particular machine or apparatus. *Bilski* at 954. A central underlying purpose of this test is to prevent a patentee from obtaining a claim that preempts all uses of a scientific principle or mathematical equation. *Id.* at 953-54.

As-amended, claims 1 and 13, and their respective dependent claims, fall within the “machine” branch of the *Bilski* test, and thus within the scope of 35 U.S.C. § 101. In particular, the methods of claims 1 and 3-14 are tied to a particular machine or apparatus, i.e., “a resonator device.”

Therefore, in view of the amendments to claims 1 and 13, the claimed invention is directed to statutory subject matter. Accordingly, Applicants respectfully request that the rejection of claims 1 and 3-14 under 35 U.S.C. § 101 be withdrawn.

Conclusion

In view of the foregoing amendments and arguments, Applicants respectfully submit that the application, including all pending claims, is in condition for allowance. An early notice of allowance is earnestly solicited.

Respectfully Submitted,
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